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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,096	02/15/2001	Kazuhiro Kusuda	Q63180	4487

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Washington, DC 20037

EXAMINER
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COBURN, CORBETT B

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 10/28/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/783,096

Applicant(s)

KUSUDA, KAZUHIRO

Examiner

Corbett B. Coburn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6,8-13,15-20,22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-13,15-20,22 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 8-13, 15-20 & 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fongeallaz in view of Filiczkowski (US Patent Number 5,106,098).

**Claims 1, 8, 15:** Fongeallaz teaches a computerized game system with a racing field formed on a predetermined board (Fig 13) that is electronically displayed on a screen. There is a running model to which an inherent ability parameter varying in accordance with a given environment is assigned. (Col 5, 41-45) The racing field (Fig 13) comprises a plurality of tracks (L1-L16) in which the running model runs based on a current ability parameter in accordance with the respective track. (Col 5, 40-56) These tracks clearly exist concurrently on the same game board. (Fig 13) Fongeallaz does not specifically teach independent tracks. Filiczkowski teaches independent tracks (abstract), i.e., a dirt track and a turf track (Fig 1B). Filiczkowski teaches that this allows the invention to closely simulate actual horse race track action. (Abstract) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Fongeallaz track in view of Filiczkowski's teachings to include independent tracks (i.e., a dirt track and a turf track) in order to simulate actual horse track action.

**Claims 2, 3, 9, 10, 16, 17:** Fongeallaz teaches the invention substantially as claimed.

Fongeallaz teaches use of a track with regions having different attributes. (Col 5, 40-62)

For instance, Fongeallaz suggests use of dry track and mud track attributes. (Col 5, 43-

45) Fongeallaz describes a steeplechase game in which there are flat regions where the

running model performs steady running in which the current ability parameter is

maximized and in other regions there is a region formed so as to obstruct the steady

running (obstacles). (Col 5, 63-66) Fongeallaz fails to explicitly teach entire tracks

where the current ability parameter of the running model is maximized or minimized.

Filiczkowski teaches a dirt track and a turf track (Fig 1B) where the current ability

parameter of the running model is maximized or minimized. Filiczkowski teaches that

this allows the invention to closely simulate actual horse race track action. (Abstract) It

would have been obvious to one of ordinary skill in the art at the time of the invention to

have modified Fongeallaz track in view of Filiczkowski's teachings to include a dirt track

and a turf track where the current ability parameter of the running model is maximized or

minimized in order to simulate actual horse track action.

**Claims 5, 12, 19:** Filiczkowski teaches that the running models can run races on both

tracks. (Abstract) The starting posts are essentially passageways formed between the

plurality of concurrently existing tracks so that the running models can enter the tracks.

The finish lines are essentially passageways formed between the plurality of concurrently

existing tracks so that the running models can exit the tracks.

**Claims 6, 13, 20:** Fongeallaz teaches the plurality of tracks form concentric racing courses. (Col 4, 36-43) Filiczkowski's Fig 1 B shows the plurality of tracks form concentric racing courses.

**Claims 4, 11, 18, 22:** Fongeallaz teaches the invention substantially as claimed.

Fongeallaz teaches use of a track with regions having different attributes. (Col 5, 40-62)

For instance, Fongeallaz suggests use of dry track and mud track attributes. (Col 5, 43-45) While Fongeallaz does not specifically teach dirt and turf track sections, these are the two main types of tracks used in horseracing. Filiczkowski teaches a dirt track and a turf track. Filiczkowski teaches that this allows the invention to closely simulate actual horse race track action. (Abstract) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Fongeallaz track in view of Filiczkowski's teachings to include a dirt track and a turf track in order to simulate actual horse track action.

3. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fongeallaz and Filiczkowski as applied to claim 22 above, and further in view of Ikeda et al. (US Patent Number 6,371,854).

**Claims 23:** Fongeallaz and Filiczkowski teach the invention substantially as claimed.

Fongeallaz teaches storing a "library" of data concerning the attributes and abilities of each running model. (Col 5, 50-62) Fongeallaz does not, however, specifically teach adding a game value to the "library" in accordance with the result of the race. Ikeda, a game in the same art, teaches allowing players to raise and train their own horses (running models). This training includes running races and recording the result of the

race in the horse's library of information. Allowing players to raise and train their own horse gives the player a greater sense of involvement in the game. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the Fongeallaz's library by add a game value to the horse's "library" of attributes in accordance with the result of the race as taught by Ikeda in order to allow the player to raise and train the horse, thus giving the player a greater sense of involvement in the game.

#### ***Response to Arguments***

4. Applicant's arguments filed 6 October 2003 have been fully considered but they are not persuasive.
5. Applicant argues that Fongeallaz fails to teach a plurality of tracks. Merriam Webster's Collegiate Dictionary (10<sup>th</sup> Edition) defines a track as the course along which something moves. Fongeallaz clearly teaches tracks. However, as Examiner pointed out in the previous office action, Fongeallaz do not teach independent tracks – which Examiner believes to be what Applicant is attempting to claim. Filiczkowski clearly teaches two independent tracks.
6. Applicant argues that Fongeallaz is incompatible with plural concurrently existing tracks. This is not the case. Fongeallaz teaches that any type of track, with any type of track condition can be simulated using the methods disclosed. Clearly, both an all dirt track and an all grass track are within the capabilities of Fongeallaz.
7. Applicant argues that Filiczkowski is not relevant because it is not a computer game. However, any number of board games has been transferred to computer. There are computerized versions of chess, checkers, backgammon, cribbage, Monopoly, Battleships, and a myriad of

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other board games. It is well known to the art that board games provide a fertile field from which ideas for computer games may be harvested. Therefore Applicant's argument that one of ordinary skill in the art would not look to board games for ideas for computer games is not persuasive.

8. Applicant argues that there is no motivation to combine the references. As pointed out above, Filiczkowski teaches that having different types of independent tracks allows the game to better simulate the two main types of horse track. Clearly in a racing simulation such as taught by Fongeallaz there is a motivation to better simulate actual racing.

9. Applicant argues that the prior art fails to teach the limitations of the dependent claims by pointing out the shortcomings of a single reference. For instance, in regard to claims 2, 3, 9, 10, 16 & 17, Applicant argues that Filiczkowski fails to teach computerized running models. But, as pointed out in the rejection, Fongeallaz does. It is the combination of references that must be addressed.

10. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

11. Applicant's arguments that the prior art does not teach passageways is based on an assumption not in the claims. Filiczkowski's starting post and finish lines perform the functions of passageways – they are where the horses enter and leave the track. They are not physical passageways, but no physical passageway is required unless the "running model" is a physical device. This limitation does not appear in the claims.

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***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (703) 305-3319. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

  
cbc

  
JESSICA HARRISON  
PRIMARY EXAMINER